

REMARKS

This responds to the Decision on Appeal mailed on September 21, 2007.

Claims 27, 35, 38 and 46 are amended, claims 1-26, 30, 36-37, 41 and 47-48 are canceled, and claims 49-56 are added; as a result, claims 27-29, 31-35, 38-40, 42-46 and claims 49-56 are now pending in this application.

§103 Rejection of the Claims

Claims 27-29, 31-35, 38-40 and 42-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carlin et al. (U.S. 6,119,152; hereinafter Carlin) and “Domain Names – Concepts and Facilities” (hereinafter RFC 1034).

Applicants respectfully submit that the rejection of the aforementioned claims under 35 U.S.C. § 103 is defective for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

Applicable Law

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. §2142. In the recent decision of the Supreme Court on *KSR Int’l Co. v. Teleflex Inc.*¹, the analysis of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*², was reaffirmed. The Court in *Graham* set out an objective analysis for applying §103 as follows:

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.”³

When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor,

¹ 127 S.Ct. 1727, 82 USPQ.2d 1385 (2007).

² 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

³ The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

would have been led to make the combination recited in the claims.” *In re Kahn*⁴. In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co. of Kansas City*⁵. Further, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*⁶. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*⁷. Office personnel must rely on the applicant's disclosure to properly determine the meaning of the claims. *Markman v. Westview Instruments*⁸.

Applicants believe that the issue of patentability over Carlin in combination with RFC 1034 can best be understood with regard to claim 27.

Claim 27, as amended, includes the following limitation:

a first sales interface at a first network address...

a second sales interface at a second network address....

a sales server at a third network address that operates the first and second sales interfaces...the sales server is operative to create the impression that the sales interfaces are being operated by different domains ...the first sales interface includes links to a first set of pages not operated by the sales server but being mapped to the first domain, and the second sales interface includes links to a second set of pages not operated by the sales server but being mapped to the second domain

a first member server at a fourth network address to operate the first set of pages; and

a second member server at a fifth network address to operate the second set of pages,

The Final Office Action, in rejecting claim 27, relies on Carlin. The following is from Carlin and may be relevant:

⁴ 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

⁵ 383 U.S. 1 at 467.

⁶ 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

⁷ 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

⁸ 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd*, U.S., 116 S. Ct. 1384 (1996).

In the present invention, a multi-provider on-line service offers a number of on-line services. The multi-provider on-line system may be uniquely configured by a plurality of service providers, such that each service provider can offer its own subset of features to its subscribers and customize the appearance of the user interface. Each subscriber is associated with a service provider, typically through a subscriber ID. When a subscriber logs on to the on-line system, he or she may access the subset of features determined by the service provider.

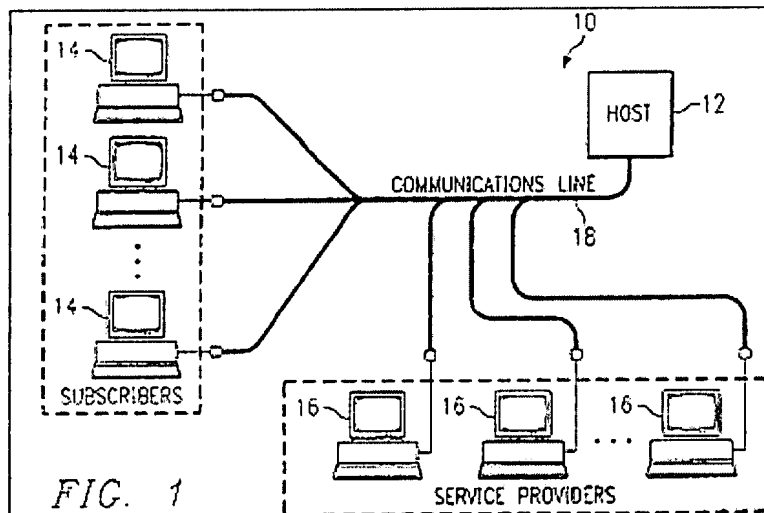
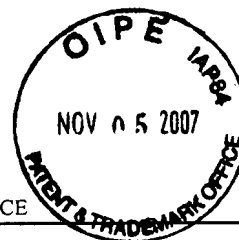
The present invention provides significant advantages over the prior art. A company or individual who wishes to provide a private on-line system can customize the multi-provider on-line system to offer the desired features. Subscribers to a particular service have access only to those features chosen by their service provider, and subscribers to other services on the multi-provider on-line service do not have access to the particular service's private data, unless such data has been authorized for public use. Hence, each provider can generate an on-line service which appears to the subscriber to be an independent on-line service. However, because the multi-provider host can economically offer advanced features to the service providers, each service provider can offer features which might otherwise be impractical for a small service provider. Further, the service provider does not need to maintain the equipment for providing the on-line service or concern itself with billing matters.

Carlin, col. 2, lines 10-38.

The above quote from Carlin relates a multi-provider on-line system. The multi-provider on-line system may be configured by multiple service providers. Each service provider may offer its own subset of features to its subscribers. Subscribers to a particular service have access only to those features chosen by their service provider. The multi-provider host can offer advanced features to the service providers that might otherwise be impractical for a small service provider. The service provider does not need to maintain the equipment for providing the on-line service or concern itself with billing matters.

The following figures from Carlin highlights the multi-provider on line system:





provider on-line system of the present invention.

Carlin, Figure 1 and Col. 3, lines 14-17.

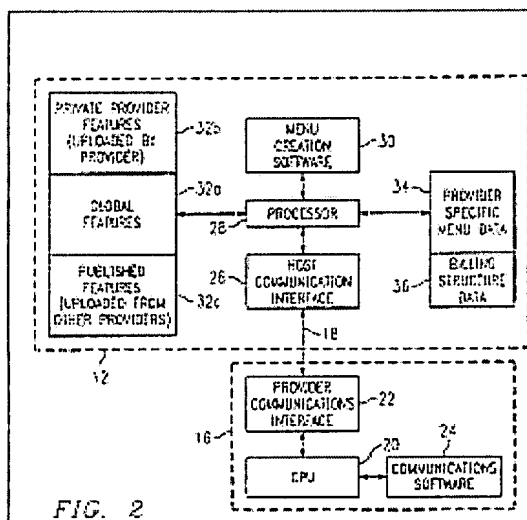


FIG. 2 illustrates a functional block diagram illustrating the operation of the host 12 and a service provider terminal 16 in connection with definition of a private on-line service.

Carlin, Figure 2 and Col. 5, lines 55-58.

The above Figures and quotes from Carlin illustrate and describe the multi-provider system including a host computer 12, subscriber terminals 14 and service provider terminals 16.

Claim 27 requires “a first sales interface at a first network address”... “a second sales interface at a second network address”... “a sales server at a third network address that operates the first and second sales interfaces”... “the sales server is operative to create the impression that the sales interfaces are being operated by different domains”... “the first sales interface includes links to a first set of pages not operated by the sales server but being mapped to the first domain, and the second sales interface includes links to a second set of pages not operated by the sales server but being mapped to the second domain,” a first member server at a fourth network address to operate the first set of pages” and “a second member server at a fifth network address to operate the second set of pages.”

In contrast, the above from Carlin relates a multi-provider on-line system that provides on-line service to the subscribers and service providers that do not provide on-line service to the subscribers. Specifically, the service provider terminals 16 in the above Figure from Carlin are merely used to configure the host and are not used to not provide on-line services to the subscribers. Claim 27 requires a sales server that operates a first and second sales interfaces, a first member server that operates a first set pages, and a second member server that operates a second set of pages, the first sales interface including links to the first set of pages not operated by the sales server, and the second sales interface including links to a second set of pages not operated by the sales server. Accordingly, the above from Carlin cannot be said to teach or suggest the limitations of claim 27.

Moreover, Carlin may be said to teach away from the solution of claim 27 because Carlin considers it advantageous for the host to exclusively provide on-line services to the subscribers. Carlin highlights the following advantages: 1) “the multi-provider host can economically offer advanced features to the service providers;” 2) “each service provider can offer features which might otherwise be impractical for a small service provider” and 3) “the service provider does not need to maintain the equipment for providing the on-line service or concern itself with billing matters.”⁹

Carlin therefore cannot be said to teach or suggest the above quoted limitation of claim 27 because Carlin relates a multi-provider on-line system that provides on-line service to the

⁹ Carlin, col. 2, lines 30-39.

subscribers and service providers that do not provide on-line service to the subscribers and claim 27 requires “a first sales interface at a first network address”...

“a second sales interface at a second network address”... “a sales server at a third network address that operates the first and second sales interfaces”... “the sales server is operative to create the impression that the sales interfaces are being operated by different domains”... “the first sales interface includes links to a first set of pages not operated by the sales server but being mapped to the first domain, and the second sales interface includes links to a second set of pages not operated by the sales server but being mapped to the second domain,” a first member server at a fourth network address to operate the first set of pages” and “a second member server at a fifth network address to operate the second set of pages.”

The portion of RFC 1040 quoted by the Final Office Action relates to a relationship between a domain and a sub-domain. Accordingly, RFC 1040 cannot supply what Carlin lacks.

The above remarks are also applicable to a consideration of independent claims 35, 38 and 46.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 28, 29, 31-34, 39-40, and 42-45 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Carlin, whether considered separately or in combination with RFC 1040, fails to teach or suggest each and every limitation of independent claims 27, 35, 38 and 46 as is required to support a *prime facie* case of obviousness in rejecting of the independent claims of the present application under 35 U.S.C. § 103.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

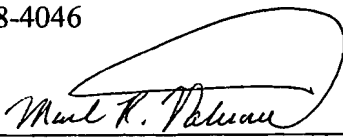
Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

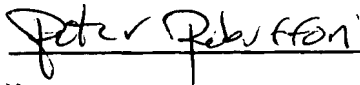
Respectfully submitted,

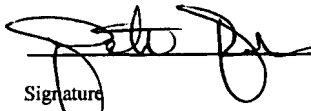
SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
408-278-4046

Date November 1, 2007

By /  /
Mark R. Vatuone
Reg. No. 53,719

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 1 day of November 2007.


Name


Signature